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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/762,836

01/22/2004

Terry L. Riss

341.029US1

5868

21186 7590 02/02/2007

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MINNEAPOLIS, MN 55402

EXAMINER

MARTIN, PAUL C

ART UNIT

PAPER NUMBER

1657

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/762,836

Applicant(s)

RISS ET AL.

Examiner

Paul C. Martin

Art Unit

1657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) 15-84 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12, 85, 86 and 88-90 is/are allowed.
- 6) ☒ Claim(s) 87 is/are rejected.
- 7) ☒ Claim(s) 13, 14 and 91 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/6/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Notice to Comply.

DETAILED ACTION

Claims 1-91 are pending in this application, Claims 15-84 were withdrawn as being directed toward non-elected inventions, Claims 85-91 are acknowledged as added.

Specification

The application contains sequence disclosures that are encompassed by the definition for nucleotide and/or amino acid sequences set forth in 37 C.F.R. 1.821(a)(1) and (a)(2). However, the application fails to comply with the requirements of 37 C.F.R. 1.821(a)(1) and (a)(2) for the reasons set forth in the attached Notice to Comply With Requirements for Patent Applications Containing Nucleotide Sequence Disclosures And/Or Amino Acid Sequence Disclosures. (See Specification Pg. 21, Table 2 and the use of Z-DEVD, Z-LETD and Z-LEHD throughout the specification) Although an examination of this application on the merits can proceed without prior compliance, compliance with the Sequence Rules is required for the response to this Office action to be complete.

The use of the trademarks TERGITOL, CYTOFLUOR and PRIONEX for example, has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

Claims 13, 14 and 91 are newly objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1 requires the contacting of a sample with a reaction mixture for the first reaction and for the second reaction, which is interpreted by the Examiner as a mixture containing reaction components for both the first and second reactions. As such, the limitation of Claim 13 requiring the sample be contacted with the reaction mixture for the second reaction before the reaction mixture for the first reaction is not possible. Claims 14 and 91 are moot as its limitation is already found in Claim 1.

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Claim 87 is objected to because of the following informalities: The terms BODIPY and TEXAS RED should be followed by the chemical names that the terms indicate. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 87 is newly rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 87 contains fluorophores not found or originally described in the disclosure and which would change the scope of the originally filed claims such as Cy3, rhodol, Rox, 5-carboxyfluorescein, 6-carboxyfluorescein, anthracene, 2-amino-4-methoxynaphthalene, phenalenone, acridone, α -naphthol, β -naphthol, 1-hydroxypyrene, coumarin, tetramethylrhodamine, carboxymethylrhodamine and cresyl. See *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320 (2000) While reiterating that "naming is not essential," the court nevertheless insisted on having "blaze marks."²⁸

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The court reasoned that "one cannot disclose a forest in the original application and then later pick a tree out of the forest and say here is my invention."²⁹ To prevent this type of overreaching by the inventor, the court held that "to satisfy the written description requirement, the blaze marks directing the skilled artisan to that tree must be in the *originally filed* disclosure."³⁰ THIS IS A NEW MATTER REJECTION.

Claim Rejections - 35 USC § 102

Applicant's arguments, see Remarks, filed 11/06/06, with respect to the rejection of Claims 1-5, 8-10 and 14 under 35 U.S.C. 102(b) as being anticipated by Grant *et al.* (2002) have been fully considered and are persuasive. The rejection has been withdrawn.

Claim Rejections - 35 USC § 103

Applicant's arguments, see Remarks, filed 11/06/06, with respect to the rejection of Claims 1-14 under 35 U.S.C. 103(a) as being unpatentable over Grant *et al.* (2002) in view of Bronstein *et al.* (US 6,586,196) have been fully considered and are persuasive. The rejection has been withdrawn.

Conclusion

Claims 1-14 and 85-91 are free of the art, Claims 1-12, 85, 86 and 88-90 are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

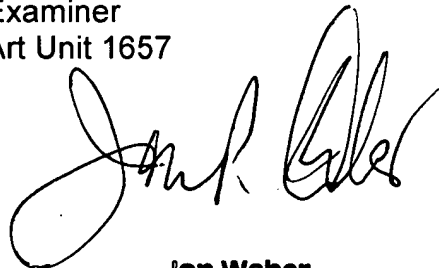
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul C. Martin whose telephone number is 571-272-3348. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

01/26/07

Paul Martin
Examiner
Art Unit 1657

A handwritten signature in black ink, appearing to read 'Jon Weber', is written over the printed name and title.

Jon Weber
Supervisory Patent Examiner

Notice to Comply	Application No.	Applicant(s)	
	10/762,836	RISS ET AL.	
	Examiner	Art Unit	
	Paul C. Martin	1657	

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).
- ☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☒ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☐ 7. Other:

Applicant Must Provide:

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (571) 272-2510 or (571) 272-2533

For CRF Submission Help, call (571) 272-2510 or (571) 272-2533

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